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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,603	04/16/2004	James D. Thacker	8109.005.US	8050

7590 04/20/2007
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EXAMINER

KIM, YUNSOO

ART UNIT	PAPER NUMBER
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1644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/825,603

Applicant(s)

THACKER ET AL.

Examiner

Yunsoo Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 25-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' amendments to the claims and submission of new claims filed on 1/25/07 has been acknowledged. Claims 1-19 and 25-41 are pending and under consideration
2. Applicant is invited to file IDS for consideration.
3. Claim 1 is objected to because of the following informality – "is couple to" on line 3 should be "is coupled to".
4. In light of Applicants' amendments to the claims, the following rejections remain.
5. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out this invention.
6. Claims 1-19 and 25-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated peptide consisting a nonapeptide as in SEQ ID NOs: 1-3 and 5 wherein the nonapeptide consists of up to three fatty acids are selected from the group consisting of stearic acid, arachidic acid and arachadonic acid, does not reasonably provide enablement for any isolated peptides having an amino acid terminus and a carboxy terminus comprising the SEQ ID NO:1-3 or 5, any isolated peptides comprising an nonapeptide or any isolated peptides comprising the SEQ ID NOs: 1-3 or 5. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use of the invention commensurate in scope with these claims for the reasons set forth in the office action mailed 10/25/06.

Applicants' arguments filed on 1/25/07 have been fully considered but they were not persuasive.

Applicants' traversed the rejection based on that the amendments to the claims would obviated the rejection.

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However, the amended claims still read on isolated peptide of any length comprising the SEQ ID NOs:1-3 or 5 with plurality of fatty acids upto 3.

The term “comprising” or “having” in claim 1 is open-ended. It expands the amino acid sequence of SEQ ID NO:1-3 and 5 to include additional non-disclosed amino acids. The SEQ ID NO:3 and SEQ ID NOs: 1, 2 and 5 are oligopeptides consist of 6 and 9 amino acids, respectively. The specification does not provide sufficient guidance as to which amino acid sequence can be added to the oligopeptides which retain a distinct functional property such as immunostimulating property of the SEQ ID NO:1-3 and 5.

The art recognizes that even minor structural differences among structurally related compounds or compositions can result in substantially different or deleterious biological activities. Ngo *et al* teach that the amino acid positions within the polypeptide/protein that can tolerate change such as conservative substitution or no substitution, addition or deletion which are critical to maintain the protein's structure will require guidance (see Ngo et al., 1994, The Protein Folding Problem and Tertiary Structure Prediction, pp. 492-495 in particular, of record).

In re Fisher, 166 USPQ 18 indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. Since the amino acid sequence of a polypeptide determined its structural property, predictability of which amino acid fragment can retain the functional capabilities of the TGF-beta comprising polypeptide requires knowledge of, and guidance with regard to, which segments in the polypeptide's sequence contribute to its function.

Therefore, there is insufficient direction as to how to make any isolated peptide having an amino acid terminus and a carboxy terminus comprising the SEQ ID NO:3 any isolated peptides having an amino acid terminus and a carboxy terminus comprising the SEQ ID NO:1-3 or 5, any isolated peptides comprising an nonapeptide or any isolated peptides comprising the SEQ ID NOs: 1-3 or 5 which can be used as to whether such a desired effect can be achieved or predicted, as encompassed by the claims.

In view of the quantity of experimentation necessary, the limited working example, the unpredictability of the art, the lack of sufficient guidance in the specification, and the breadth of the claims, it would take undue trials and errors to practice the claimed invention.

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7. Claims 1-19 and 25-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the office action mailed 10/25/06.

Applicants' arguments filed on 1/25/07 have been fully considered but they were not persuasive.

Applicants' traversed the rejection based on that the amendments to the claims would obviate the rejection.

However, the amended claims still read on isolated peptide of any length comprising the SEQ ID NOs: 1-3 or 5 with plurality of fatty acids up to 3.

Consequently, conception in either case cannot be achieved until a representative description of the structural and functional properties of the claimed invention has occurred, regardless of the complexity or simplicity of the method. Adequate written description requires more than a mere statement that it is part of the invention. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993).

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the written description inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116). Consequently, Applicant was not in possession of the instant claimed invention. See University of California v. Eli Lilly and Co. 43 USPQ2d 1398.

Applicant is directed to the Revised Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

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8. The following new grounds of rejections are necessitated by Applicants' amendments filed on 1/25/07.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-19 and 25-41 are rejected under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "effective" in claim 1 (line 4) and the phrase "low toxicity and a low incidence" in claim 28 are relative term and phrase which render the claims indefinite. The term and the phrase are not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree and one of the ordinary skill in the art would not be reasonably apprised the metes and bounds of the invention.

11. No claims are allowable.

The isolated polypeptide consisting of the SEQ ID NOs:1-3 or 5 is free of art.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

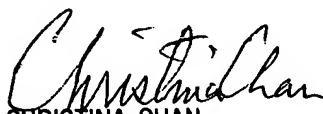
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yunsoo Kim whose telephone number is 571-272-3176. The examiner can normally be reached on Monday thru Friday 8:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yunsoo Kim
Patent Examiner
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April 11, 2007


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